

REMARKS

By this amendment, Applicants amend claims 18, 50, 69, 76, 79, and 86, and cancels claims 23-27, 55-59, 70, 77, 81, 83-85, and 88-91 without prejudice or disclaimer. Accordingly, claims 18-22, 50-54, 69, 76, 79, and 86 remain pending in this application.

In the Final Office Action¹, the Examiner took the following actions:

rejected claims 18-22, 26, 50-59, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King et al. (U.S. Patent Application Publication No. 2002/0002590) in view of Whitehouse (U.S. Patent No. 5,341,505); and

rejected claims 23-25, 27, 55-57, 59, 70, 77, 81, 83, 85, 88-90, and 91 under 35 U.S.C. § 102(e) as being anticipated by King.

I. REJECTION OF CLAIMS 18-20, 22, 50-52, 54, 55-57, 59, 69, 76, 79, AND 86 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 18-20, 22, 50-52, 54, 55-57, 59, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King in view of Whitehouse. The rejection with respect to cancelled claims 26 and 55-59 is now moot. A *prima facie* case of obviousness has not been established for the pending claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 18 recites, in part, “receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user’s electronic account and a non-standardized physical address of the user, and wherein the non-standardized physical address includes a physical street address, a city name, a state name, and a 5-digit ZIP code.”

In contrast, according to the King system, a sender manually enters a physical address of a recipient or chooses a physical address of the recipient. King, paragraph [0018]. If the sender does not know the recipient's physical address, then the physical address can be determined by "searching based on the recipient's telephone number, zip code, state, or by any other information that is useful in the event that the sender does not know the physical address of the recipient." Id. at paragraph [0022].

However, the messages used by the King system do not constitute or suggest Applicant's claimed "message," which includes **"an electronic address associated with the user's electronic account and a non-standardized physical address of the user . . . [that] includes a physical street address, a city name, a state name, and a 5-digit ZIP code"** (emphases added).

The Final Office Action refers to paragraphs 18-23 of King. Specifically, the Final Office Action refers to an example discussed in paragraph 20 where a message is sent to Santa. As disclosed by King:

if the sender only knows Santa's name, the sender enters a search mode that would automatically populate an addressee line of the e-mail software package with Santa's physical address upon entry of Santa's name in the search string. Thus, the sender would enter "Santa Claus" (and/or other identifying information) as the search string, in step 140. The system would then respond by automatically placing Santa's address in the addressee field of the e-mail software package and routing the e-mail to Santa's electronic inbox located on the e-mail server. In one embodiment, the address is populated from a proprietary list. In yet another embodiment, the address is populated from a list provided by the sender (e.g., his electronic address book).

King, paragraph [0020] (emphases added).

As set forth above, a sender using the King system may enter a name (e.g.,

"Santa Claus"), which may cause the system to automatically place an address for that name in the addressee field of an e-mail address. That is, King teaches a message having an e-mail address, but the message in King does not include an e-mail address **and** a non-standardized physical address. Accordingly, King does not teach or suggest Applicant's claimed "message," which includes "**an electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user . . . [that] **includes a physical street address, a city name, a state name, and a 5-digit ZIP code**" as recited in independent claim 18 (emphases added).

King further discloses:

if the sender knows the physical address of the recipient Santa, the recipient can manually enter the address in the address line of the e-mail software application (e.g. Groupwise.RTM., Microsoft Mail.RTM.). In such a situation, the sender enters "123 North Pole Lane, NorthPole, U.S.A." The e-mail server then receives the e-mail and determines that that particular e-mail should be routed to Santa's electronic in-box located on an e-mail server.

King, paragraph [0019].

As set forth above, the King system can receive an email including a physical address and determine an electronic in-box for the email. While King teaches a message having a physical address, the message does not include an e-mail address **and** a non-standardized physical address. Accordingly, King does not teach or suggest Applicant's claimed "message," which includes "**an electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user . . . [that] **includes a physical street address, a city name, a state name, and a 5-digit ZIP code**," as recited in independent claim 18 (emphases added).

Whitehouse, which was cited for allegedly supporting the obviousness of using "9 digit zip codes" (Final Office Action at page 3) does not overcome the deficiencies of King. That is, Whitehouse also does not teach or suggest Applicant's claimed "message," which includes "**an electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user . . . [that] **includes a physical street address, a city name, a state name, and a 5-digit ZIP code**," as recited in independent claim 18 (emphases added).

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Consequently, the Final Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and the Examiner should withdraw the rejection of independent claim 18 under 35 U.S.C. § 103(a).

Independent claims 50, 69, 76, 79, and 86, although of a different scope from each other and claim 18, each include recitations that are similar to claim 18. Accordingly, a *prima facie* case of obviousness has not been established for claims 50, 69, 76, 79, and 86 for at least the same reasons discussed above. Therefore, for at least the above reasons, the Examiner should also withdraw the rejection of claims 50, 69, 76, 79, and 86 under 35 U.S.C. § 103(a).

Dependent claims 19-22 and 51-54 depend from one of allowable independent claims 18 and 50, and are allowable at least due to their dependence. Accordingly, the

Examiner should also withdraw the rejection of dependent claims 19-22 and 51-54 under 35 U.S.C. § 103(a).

II. REJECTION OF CLAIMS 23-25, 27, 55-57, 59, 70, 77, 81, 83, 85, 88-90, AND 91 UNDER § 102(e)

Although Applicants respectfully traverse the rejection of claims 23-25, 27, 55-57, 59, 70, 77, 81, 83, 85, 88-90, and 91 under 35 U.S.C. § 102(e) as being anticipated by King, in view of the cancellation of these claims, the rejection is now moot.

CONCLUSION

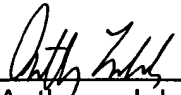
Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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